

REMARKS

Applicant thanks the Examiner for identifying allowable subject matter in claims 6 and 10-18.

In the Office Action dated April 22, 2004, claims 1-3 and 19 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,185,535 to Hedin et al. (hereinafter "Hedin") in view of U.S. Patent No. 6,584,327 to Nilsson (hereinafter "Nilsson"); and claims 7, 8 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Nilsson. Applicant respectfully traverses the rejections of record.

Rejections under 35 U.S.C. § 103(a)

Claims 1-3 and 19 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hedin view of Nilsson. Applicant respectfully traverses these rejections.

First and foremost, Applicant submits that the combination of the references which form the basis of the § 103 rejections is improper. The Examiner's only stated basis for combination of the references is that they "are combinable since they share a common endeavor, namely remote terminals that accept limited vocal input for control functions." Office Action, p. 4.

However, Applicant submits that this is *not* a proper basis for combination of references under § 103. As the Court of Appeals for the Federal Circuit has held:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

In re Oetiker, 24, U.S.P.Q.2d 1443, 1447, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

There is no “reason, suggestion, or motivation” in the prior art such that one of ordinary skill in the art would make the combination of Hedin and Nilsson which forms the basis of the rejections under 35 U.S.C. § 103(a) in the Office Action. This combination of elements between non-analogous sources, i.e., the voice control application of Hedin and the mobile telephone and telecommunications system of Nilsson, is apparently improperly made only with the benefit of hindsight in view of the present application. In much the same way that one seeking to solve a problem of "fastening a hose clamp" would not "reasonably be expected or motivated to look to fasteners for garments" for a solution, it is equally unlikely that one seeking to solve a problem in single-mode satellite systems would reasonably look to “dual-mode” cordless and cellular phone systems for limiting telephone service costs. *See id.*

Even if Hedin and Nilsson can be considered to be analogous art, the Federal Circuit has held that the mere fact that a prior art device *could* be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *See, e.g., In re Gordon*, 221 U.S.P.Q. 1125, 733 F.2d 900 (Fed. Cir 1984). No such suggestion appears in either Hedin or Nilsson, and the Examiner has not even asserted that such a suggestion is found anywhere in these references or elsewhere in any prior art.

Accordingly, because there is no teaching or suggestion towards the cited combination in the prior art, in conformity with the law as recited by the Federal Circuit, these references are not properly combined. Applicant therefore respectfully submits that the rejections of claims 1-3 and 19 under 35 U.S.C. § 103(a) are improper for at least this reason, and submits that these claims are in condition for allowance.

Furthermore, with respect to independent claim 7 and corresponding dependent claims 8 and 20, the Examiner alleges that these claims are unpatentable over Nilsson. Applicant respectfully disagrees.

Claim 7 is directed to a mobile device comprising:

a microphone for receiving sound signals;

an interface, connected to said microphone for converting received sound signals from said microphone to data signals;

a radio module for sending wireless data communication signals; and

a digital signal processor, said processor including a program for (1) recognizing a limited number of digital data signals from said interface and operating in response thereto to control said radio, (2) operating said radio module to send digital data signals, and (3) providing digital data signals corresponding to sounds from said microphone as data packets to said radio module.

Nilsson is directed to a mobile telephone instrument and wireless telecommunications system which provides, *inter alia*, voice dialing functions. See Nilsson, Abstract.

First, the Examiner cites to col. 3, lines 4-11 of Nilsson as allegedly disclosing or suggesting “an interface, connected to said microphone for converting received sound signals from said microphone to data signals.” Office Action, p. 5. Nothing in this cited text of Nilsson even remotely suggests conversion of received sound signals into data signals.

Furthermore, nothing in the portion of Nilsson cited by the Examiner (cp., 3, lines 4-60) discloses or suggests “a digital signal processors, said processor including a program for recognizing a limited number of digital data signals from said interface and operating in response thereto to control said radio” or “operating said radio module to send digital data signals,” as those limitations are recited in claim 7. Certainly, even if there is some suggestion by implication of these features in the Nilsson reference, the reference is not enabling in these respects, and thus cannot form the basis of a §103 rejection. “In order to render a claimed

apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” *Beckman Instruments, Inc. v. LKB Produktor AB*, 13 U.S.P.Q. 1301, 892 F.2d 1547 (Fed. Cir. 1989).

For at least these reasons, Applicant respectfully submits that independent claims 7 is not obvious in view of the cited Nilsson reference. Furthermore, because claims 8 and 20 depend from claim 7, applications respectfully submit that claims 7, 8 and 20 are not obvious in view of Nilsson and are accordingly in condition for allowance.

CONCLUSION

In view of the foregoing amendment and remarks, favorable reconsideration and allowance of claims 1-3, 7-8 and 19-20 are respectfully solicited. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,



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